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10/047,307	01/15/2002	Thomas E. Murphy JR.	END920010094US1	5180

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EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3692

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/047,307	Applicant(s) MURPHY ET AL.	
	Examiner JENNIFER LIVERSEDGE	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for continued examination of Application 10/047,307 filed on May 20, 2008.

The amendment contains original claims: 4, 6-9, 11, 13-15, 18-21, 23-26.

The amendment contains previously presented claims: 1-3, 5, 10, 12, 16-17, 22.

* Claim 1 is listed as previously presented in the listing of claims. However, it is actually amended from the claim language as was finally rejected.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 20, 2008 has been entered.

Claim Objections

Claim 1 is objected to because of the following informalities: the first limitation cites "using a transactional device used for a making payment..." which is grammatically incorrect. Appropriate correction is required.

Claim 3 is objected to because of the following informalities: claim 3 contains an attorney note, "(how)", within the claim language. Appropriate correction is required.

Claim 16 is objected to because of the following informalities: claim 16 refers to alerting a clerk regarding "the contact". The reference to "the contact" is referring back to contact being made by a third party sender. While the issue does not fully rise to the level of lacking antecedent basis, as there is a contacting step in claim 10, it is awkwardly phrased in that examiner believes that the clerk is alerted to a message awaiting for the credit card user rather than contact having been made by a third party sender.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5, 8-9 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites attaching an alert code to transaction data in response to the transaction request, prior to the receiving of the transaction request. It is unclear how an alert code can be attached to a transaction request before the transaction request is received. For purposes of examination, examiner will assume that the alert code is attached to a user's transactional device data file prior to a transaction, and then attached to transaction data when the transaction data is received.

Claims 8-9 recite the limitation "the transaction code". There is insufficient antecedent basis for this limitation in the claim.

Claims 22 recites a program product stored on a recordable medium...which when executed comprises...program code. It is unclear as to the grammatical flow in the claim language. Typically, when program code is executed, the result is an action and not further code. It would seem that the program code configured to carry out various steps would already be a part of the software, and would not be contingent on execution. For purposes of examination, examiner will assume that it is meant that the program code is executed to perform the steps as recited in the limitations.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claim fails to result in a real world, tangible and useful result. The claim cites receiving an alert code attached to transaction data, but the claim language fails to indicate that the code and data are ever presented in the real world, and as currently stated, could merely be the transfer of electronic data which never is provided to or visible to a user of the transactional device.

Claims 22-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 22 is directed to a program product stored on a recordable medium. Software is not a statutory class. The 101 rejection could be overcome by instead claiming a computer readable medium with executable instruction stored thereon.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 6-7, 10-13 and 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7,287,009 B1 to Liebermann (further referred to as Liebermann), and further in view of "Pagers Infiltrating" by Andy Pargh (further referred to as Pargh).

Regarding claim 1, Liebermann discloses a method for receiving an alert in a commercial transaction (columns 4-27), comprising the steps of:

Using a transactional device used for making payment in a commercial transaction (column 10, lines 8-10 and lines 47-49; column 17, lines 54-65; column 18, lines 16-19); and

Receiving an alert attached to transaction data for the commercial transaction indicating receipt of a message personally directed from a third party sender that is not involved in the commercial transaction to a user of the transactional device, the contents of the message being independent from the commercial transaction (column 4, lines 60-67; column 5, lines 56-67; column 17, lines 54-65; column 18, lines 6-19).

Liebermann does not specifically disclose an alert code. However, Pargh discloses an alert code (page 1, paragraphs 3-4; page 2, paragraphs 1-2). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the providing of an alert attached to transaction data notifying a customer using a credit card at a POS that a personal message unrelated to the transaction is awaiting him/her as disclosed by Lieberman to adapt the use of alert codes as disclosed by Pargh. The motivation would be that Lieberman discloses providing an indication of an awaiting message, not the message itself, and therefore some sort of coding is being used to represent the message and notify the user of an awaiting message. The use of alert codes provides for an efficient and effective means of information transfer.

Regarding claim 10, Lieberman discloses a method for receiving an alert in a commercial transaction (columns 4-27), comprising the steps of:

Contacting a message center with a message from a third party sender that is not involved in the commercial transaction (column 18, lines 6-8);

Using a transaction device in a commercial transaction (column 10, lines 8-10 and lines 47-49; column 17, lines 54-65; column 18, lines 16-19);

Identifying an intended recipient of the message (column 18, lines 9-11);

Attaching an alert to transaction data for the transaction, wherein the alert is unrelated to the transaction (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19);

Receiving the alert attached to the transaction data (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19); and

Retrieving the message in response to the received alert (column 15, lines 4-8; column 17, lines 54-65; column 18, lines 16-19; column 20, lines 30-37).

Liebermann does not specifically disclose an alert code. However, Pargh discloses an alert code (page 1, paragraphs 3-4; page 2, paragraphs 1-2). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the providing of an alert attached to transaction data notifying a customer using a credit card at a POS that a personal message unrelated to the transaction is awaiting him/her as disclosed by Lieberman to adapt the use of alert codes as disclosed by Pargh. The motivation would be that Lieberman discloses providing an indication of an awaiting message, not the message itself, and therefore some sort of coding is being used to represent the message and notify the user of an awaiting message. The use of alert codes provides for an efficient and effective means of information transfer.

Regarding claim 17, Lieberman discloses a system for receiving an alert in a commercial transaction (columns 4-27), comprising:

A message reception system for receiving a message from a third party sender that is not involved in the commercial transaction (column 6, lines 59-64; column 18, lines 6-8);

A recipient identification system for identifying an intended recipient of the message based upon use of a transactional device during a commercial transaction (column 8, lines 15-32; column 14, lines 40-50; column 17, lines 54-65; column 18, lines 9-11; column 19, lines 4-14);

An attachment system for attaching an alert to transaction data for the transaction (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19); and

A message transmission system for transmitting the received messages (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19).

Liebermann does not specifically disclose an alert code. However, Pargh discloses an alert code (page 1, paragraphs 3-4; page 2, paragraphs 1-2). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the providing of an alert attached to transaction data notifying a customer using a credit card at a POS that a personal message unrelated to the transaction is awaiting him/her as disclosed by Lieberman to adapt the use of alert codes as disclosed by Pargh. The motivation would be that Lieberman discloses providing an indication of an awaiting message, not the message itself, and therefore some sort of coding is being used to represent the message and notify the user of an awaiting message. The use of alert codes provides for an efficient and effective means of information transfer.

Regarding claim 22, Lieberman discloses a program product stored on recordable medium for receiving an alert in a commercial transaction (columns 4-27), comprising:

Program code configured to receive a message from a third party sender that is not involved in the commercial transaction (column 6, lines 59-64; column 18, lines 6-8);

Program code configured to identify an intended recipient of the message based upon use of a transactional device during a commercial transaction (column 8, lines 15-32; column 14, lines 40-50; column 17, lines 54-65; column 18, lines 9-11; column 19, lines 4-14);

Program code configured to attach an alert to transaction data for the commercial transaction (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19); and

Program code configured to transmit the received messages (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19).

Liebermann does not specifically disclose an alert code. However, Pargh discloses an alert code (page 1, paragraphs 3-4; page 2, paragraphs 1-2). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the providing of an alert attached to transaction data notifying a customer using a credit card at a POS that a personal message unrelated to the transaction is awaiting him/her as disclosed by Lieberman to adapt the use of alert codes as disclosed by Pargh. The motivation would be that Lieberman discloses providing an indication of an awaiting message, not the message itself, and therefore some sort of coding is being used to

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represent the message and notify the user of an awaiting message. The use of alert codes provides for an efficient and effective means of information transfer.

Regarding claim 2, Liebermann discloses:

contacting a message center with the message, prior to the using of the transactional device (column 6, lines 59-64; column 18, lines 6-8); and

receiving a transaction request after the using of the transactional device (column 10, lines 43-58; column 15, lines 4-8; column 17, lines 54-65; column 18, lines 16-19; column 20, lines 30-37).

Regarding claim 6, Liebermann discloses wherein the transactional device is selected from the group consisting of a magnetic device, and a machine-readable code containing device (column 9, lines 27-33).

Regarding claims 7, 20 and 25, Liebermann discloses wherein the alert is unrelated to the commercial transaction (column 4, lines 60-67; column 5, lines 65-67; column 17, lines 54-65; column 18, lines 6-19). The same art and rationale in combining Liebermann and Pargh regarding the alert code as was applied to claims 1, 17 and 22 apply to claims 7, 20 and 25.

Regarding claim 11, Liebermann discloses contacting the message center (column 18, lines 6-8); providing a unique identifier corresponding to the intended recipient (column 18, lines 9-11); and receiving a transaction request after the using of the transactional device (column 15, lines 4-8; column 17, lines 54-65; column 18, lines 16-19; column 20, lines 30-37).

Regarding claim 12, Liebermann discloses wherein the retrieving step comprises retrieving the message from the third party sender (column 27, lines 14-50 where participants communicate via chat). Further Pargh discloses wherein the retrieving step comprises retrieving the message from the third party sender (page 1, paragraphs 2-4; page 2, paragraphs 1-2).

Regarding claim 13, Liebermann discloses wherein the transactional device is a magnetic device (column 9, lines 27-33).

Regarding claim 18, Liebermann discloses wherein the message reception system records the message (column 6, lines 59-64; column 18, lines 6-8), and wherein the message transmission system plays the recorded message (column 15, lines 4-7; column 17, lines 54-65; column 18, lines 11-14; column 20, lines 30-32).

Regarding claim 19, Liebermann discloses wherein the recipient identification system identifies the intended recipient based upon a transaction device identification

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(column 9, lines 27-33; column 10, lines 43-53; column 17, lines 54-65; column 18, lines 6-19; column 19, lines 4-14).

Regarding claim 21, Liebermann discloses a subscription system for the intended recipient to subscribe to a message service (column 7, lines 58-60; column 8, lines 15-32).

Regarding claim 23, Liebermann discloses wherein program code configured to receive the message records the message (column 6, lines 59-64; column 18, lines 6-8), and wherein program code configured to transmit the received message plays the recorded message (column 15, lines 4-7; column 17, lines 54-65; column 18, lines 11-14; column 20, lines 30-32).

Regarding claim 24, Liebermann discloses wherein the program code configured to identify the intended recipient identifies the intended recipient based upon a transaction device identification (column 9, lines 27-33; column 10, lines 43-53; column 17, lines 54-65; column 18, lines 6-19; column 19, lines 4-14).

Regarding claim 26, Liebermann discloses program code configured to allow the intended recipient to subscribe to a message service (column 7, lines 58-60; column 8, lines 15-32).

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann and Pargh as applied to claim 1 above, and further in view of "Netcard set to debut info kiosk" by Chooi Yew Tzen (further referred to as Tzen).

Regarding claim 3, Lieberman discloses:

attaching an alert to transaction data in response to the transaction request (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19), and to user account data [per 112 interpretation] prior to the receiving of the transaction request (column 17, lines 54-65; column 18, lines 6-8); and

retrieving the message in response to the received alert (column 15, lines 4-8; column 17, lines 54-65; column 18, lines 16-19; column 20, lines 30-37).

The same art and rationale in combining Liebermann and Pargh regarding the alert code as was applied to claim 1 applies to claim 3.

Neither Liebermann nor Pargh specifically disclose sending the alert attached to a transaction code. However, Liebermann discloses sending an alert attached to transaction data (column 4, lines 60-67; column 17, lines 54-65; column 18, lines 16-19). Further, Tzen discloses a receipt with a transaction code for referring to the transaction. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the supplying of alert codes with transaction data as disclosed by Liebermann and Pargh to adapt the use of a transaction code as transaction data. The motivation would be that transaction codes are used to indicate a transaction and are frequently supplied with transaction receipts.

Regarding claim 4, Liebermann discloses wherein the retrieving step comprises:
contacting the message center (column 18, lines 11-14);
providing a unique identifier (column 6, lines 16-23); and
retrieving the message from the message center (column 6, lines 16-23; column 15, lines 4-8; column 17, lines 54-65; column 18, lines 16-19; column 20, lines 30-37).

Regarding claim 5, Liebermann discloses wherein the retrieving step comprises retrieving the message from the third party sender (column 27, lines 14-50 where participants communicate via chat). Further Pargh discloses wherein the retrieving step comprises retrieving the message from the third party sender (page 1, paragraphs 2-4; page 2, paragraphs 1-2).

Claims 8-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann and Pargh as applied to claims 1 and 10 above, and further in view of case law (*In re Kuhle*, 526 F.2d 553, 188 USPQ7 (CCPA 1975)).

Neither Liebermann nor Pargh disclose wherein the alert code is appended, prepended or embedded to or in transaction data. However, it would be obvious to one of ordinary skill in the art to place the alert code in either of an appended, prepended or embedded location relative to the transaction data. For example, in the *Kuhle* case, the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice. Applicant has offered no specific reasoning as to why

it is critical that the alert be placed in the appended, prepended or embedded location and Examiner holds that it is therefore obvious to place it in any relative location.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann and Pargh as applied to claim 10 above, and further in view of Official Notice.

Neither Liebermann nor Pargh disclose alerting a transaction clerk regarding the contact. However, Liebermann discloses where a user of a credit card is alerted that a message is awaiting him/her by use of a POS device. Examiner takes Official Notice that it is old and well known and would have been obvious to one of ordinary skill in the art at the time of the invention that the clerk would be alerted to the awaiting message. This is because clerks generally operate the POS transaction devices in terms of receiving credit card authorizations and as the transaction data is sent to the POS device in order for a clerk to be made aware as to whether the pending purchase has been authorized or not, it would then be obvious that any other data accompanying the transaction data would be made available to the clerk during that transaction process.

Response to Arguments

Examiner acknowledges receipt of Affidavits filed with the amendment submitted on May 20, 2008. While the examiner thanks the Applicant for the Affidavits as filed, Applicant is reminded of the requirements for swearing behind a reference used as prior art, the primary requirements set forth in sections 715 and 2138 of the MPEP. Section

715 provides the basic requirements for swearing behind a reference. Examiner specifically points to sections 2138.01 and 2138.06 as it relates to the deficiencies of the presently submitted Affidavits in establishing attorney and engineering due diligence from the time of the prior art reference date (June 7, 2001) and the filing of the present application (January 15, 2002), where applicant must account for the entire time period for which diligence is required, where the time period must be accounted for by affirmative acts or acceptable excuses (see below). For purposes of expeditiously pointing to the relevant portions of MPEP in addressing the deficiencies of the present Affidavits, the portions of MPEP below are provided.

2138.06 [R-1] “Reasonable Diligence”

The diligence of 35 U.S.C. 102(g) relates to rea-sonable “attorney-diligence” and “engineering-diligence” (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved...” *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974).

**CRITICAL PERIOD FOR ESTABLISHING DILIGENCE BETWEEN ONE
WHO WAS FIRST TO CONCEIVE BUT LATER TO REDUCE TO
PRACTICE THE INVENTION**

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) (“lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts”). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (*Fritsch v. Lin*, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (*Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (*Justus v. Appenzeller*, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

**THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED
MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR
ACCEPTABLE EXCUSES**

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent’s entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the

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laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) (“[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus”); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 5,661,781 to DeJager discloses a central message service wherein third party senders can submit messages and when a subscriber uses a credit, debit or calling card, the subscriber is notified that a message is waiting by way of a message indicator presented as part of the transaction data, where the message was stored previous to a transaction taking place and wherein the subscriber can retrieve the message through either data or voice mechanisms.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692